

here again for the record that the Reissue Parties deny any deceptive intention in the filing of the present reissue application.

### **BACKGROUND - THE PROTEST**

Although somewhat rambling, the deceptive intention portion of the Protest is finally summarized at page 18, lines 1-3, where it is asserted that a "rejection of reissue claims has been founded upon...a failure to demonstrate error without deceptive intention..."(emphasis in original). The Protestor's "support" or "evidence" for this assertion is presented in two broad themes:

- (1) there was a lack of good faith by the Reissue Parties in failing to point out, in the Reissue Declaration or Oath by Assignee, an allegedly "crucial and significant change" in the reissue claims (see, page 3, line 11 - page 17, line 2); and
- (2) the Reissue Parties have allegedly violated their duty of candor to the United States Patent and Trademark Office under the provisions of 37 C.F.R. §1.56. (see, page 17, lines 3-17).

Each of these themes is addressed below.

### **Remarks**

#### **I. Alleged Lack of Good Faith**

In summary, the basis for this assertion by the Protestor seems to be that the Reissue Parties had some nefarious "alternative motive" for making an allegedly "crucial and significant change" to the reissue claims, but failing to point out such change in the Reissue Declaration. The Protestor specifies the "evidence" from which the Reissue Party's intent is inferred at page 11, line 2 - page 17, line 2 of the Protest.

All of the "evidence" relates to GUMC's U.S. Patent No. 5,763,181 (the "181 Patent"). In brief, the Protestor seems to assert that the '181 Patent contains claims which the Reissue Parties are attempting to usurp by means of the present reissue application. The Protestor even goes so far as to suggest that the present reissue application is some illegal means for usurping the '181 Patent claims (see, page 16, lines 1-5).

However, the Protestor fails to explain how, on May 20, 1998 when the present reissue application was filed, the Reissue Parties knew of the claims of the '181 Patent which were published with the patent's issuance on June 9, 1998. The Reissue Parties did not know of these subsequently issued claims at the time the present reissue application was filed, and could not have known of these claims at that time absent disclosure by GUMC. Such disclosure was not made by GUMC to the Reissue Parties. Thus, the intent of the Reissue Parties at the time of filing the reissue application could not have been to somehow usurp the '181 Patent claims, nor could the Reissue Parties have had the alleged "alternative motive" for filing the present reissue application.

Similarly there was not a lack of good faith exhibited by the Reissue Parties in allegedly not pointing out more than one error to support the present reissue application. In fact, the Protestor admits that the Reissue Parties did "satisfy the requirements of 35 U.S.C. §251" with their Declaration (see, page 3 lines 12-14).

#### Alleged Violation of 37 C.F.R. §1.56

At page 17, lines 3-11, the Protestor alleges that because the Reissue Parties failed to bring the '181 Patent to the attention of the United States Patent and Trademark Office, there has been a violation of the provisions of 37 C.F.R. §1.56. However, the '181 Patent is not a prior art reference to the present reissue application. The effective filing date of the '181 Patent is December 30, 1994, and the effective filing date of the present reissue application is April 18, 1994. Thus, there has not been any violation of the provisions of 37 C.F.R. §1.56, and this does not constitute "further evidence of a clear lack of good faith" as alleged in the Protest at page 17, lines 3-6.

#### Conclusions

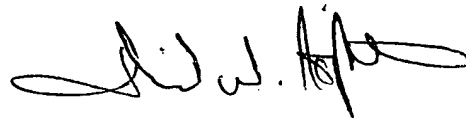
Due to the lack of any persuasive evidence to support the Protestor's inference of deceptive intention, it is respectfully submitted that the Protestor's allegations amount to little more than a public exhibit of gratuitous malice. This is unfortunate.

Also, based on Exhibit A (a letter mailed by GUMC to the undersigned shortly after the filing of the Protest, encouraging the undersigned to discuss a license to the '181 Patent), and Exhibit B (a letter mailed by GUMC to the undersigned shortly before the filing of the Protest,

and also encouraging the undersigned to discuss a license to the '181 Patent), it is further respectfully submitted that the Protest is, at least in part, some portion of a business strategy by GUMC. It is also respectfully submitted that proceedings before the United States Patent and Trademark Office are not an appropriate vehicle for application of such business strategies.

Finally, due to the adversarial nature of the Protest, and particularly in view of the gratuitous and unfounded malicious allegations therein, the undersigned believes that it is prudent to await a request from the Examiner before specifically addressing other issues raised in the Protest. The Examiner will review these other issues, and if, in his objective, rather than adversarial, view the other issues have merit, the Applicants and the undersigned will gladly address the Examiner's concerns.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David W. Highet', with a stylized flourish at the end.

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P-2821RI response to protest